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09/977,664

10/15/2001

Robert D. Herpst

3468

26009

7590

06/29/2007

ROGER M. RATHBUN

13 MARGARITA COURT

HILTON HEAD ISLAND, SC 29926

EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1743

MAIL DATE

DELIVERY MODE

06/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/977,664

Applicant(s)

HERPST, ROBERT D.

Examiner

Lyle A. Alexander

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,10,11,15-20,28,30-33,35-37,39-44 and 46-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 10,11, 15-20, 28,30-33,35-37, 39-44 and 46-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 10,11, 15-20, 28,30-33,35-37, 39-44 and 46-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims state “an infrared light transmitting crystal”. However, the specification only teaches an alkali halide crystal. The claims should be limited to the specific crystal taught in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20, 28,30-33,35-37 and 30-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite what type of crystal “an infrared light transmitting crystal” intends. Will the instant invention work with any crystal or only an alkali halide crystal.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claim 1-2, 10,11, 15-20, 28,30-33,35-37, 39-44 and 46-53 are rejected under 35 U.S.C. 103(a) as being unpatentable Gagnon et al. (USP 5,764,355) in view of Eden et al. (USP 4,843,030), further in view of Applicants' admitted prior art (pages 3-8 of the original specification) or Izumi (USP 4,932,780).

See the appropriate paragraph of the 5/11/06 Office action.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gagnon et al. (USP 5,764,355) in view of Eden et al., further in view of Applicants' admitted prior art (pages 3-8 of the original specification) or Izumi (USP 4,932,780) together further in view of Marker et al. (4,855,110).

See the appropriate paragraph of the 5/11/06 Office action.

### ***Response to Arguments***

Applicant's arguments filed 3/28/07 have been fully considered but they are not persuasive.

Applicants' state Gagnon et al. cannot be read on the instant invention because Gagnon et al. fail to teach the claimed infrared transmitting materials. The instant claim language of "an infrared light transmitting crystal" appears to be unsupported by the original specification. In light of the above 35 USC 112 first and second paragraph issues, the Office has interpreted the invention as device having a light transmitting sample holder that is indistinguishable from the instant claims.

Applicants' states there are problems or disadvantages with the device taught by Gagnon et al. The Office maintains the instant claims language is indistinguishable from the cited prior art and has been properly applied.

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In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants' state Gagnon et al. does not teach the claimed quartz material to support the sample. Column 5 lines 33+ teach the holder material can be glass, quartz, etc.

Applicants state the differenced between the use of a screen and a crystal is profound. The instant claims do not claim a crystal and exclude the taught receiving means (14).

Applicants' traverse the application of Eden et al. stating this reference does not teach cleaving the crystal to achieve IR radiation transmission. The Office maintains Eden et al. has been properly applied as teaching in the art it is known to prepare NaCl substrates from cleaving the crystal.

Applicants' state Izumi teaches requiring polishing the crystal and it is incorrect to use this reference as teaching motivation not to polish the crystals. The Office maintains Izumi teaches polishing is expensive and has been properly cited to teach this.

Applicants' traverse the application of In re Leshin noting it is directed to different technology (e.g. polymers) than presently claimed. The Office maintains Leshin has been properly applied to the pending claims in that the selection of a material based upon its suitability of intended use is within the skill of the art.

The 3/28/07 1.132 Declarations have been considered. MPEP 716.01(c) III states, "Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at

issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. In re Chilowsky, 306 F.2d 908, 134 USPQ 515 (CCPA 1962)". The statements made by Dr. Haseth and Dr. Smolyarenko are held in very high esteem. However, in the absence of factual evidence, these statements have been considered as opinion testimony and not convincing to overcome the rejections of record.

Re: Commercial success - For commercial success - In ex parte proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See In re Huang, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) Merely showing that there was commercial success of an article which embodied the invention is not sufficient. Ex parte Remark, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) The Examiner submits that Applicant has given no nexus between the claimed features and the commercial success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Lyle A Alexander  
Primary Examiner  
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A handwritten signature in black ink, appearing to be 'Lyle A. Alexander', located below the printed name.